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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,747	04/09/2004	Je-hyoung Ryu	1572.1241	8808
21171	7590	02/22/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				NGHIEM, MICHAEL P
ART UNIT		PAPER NUMBER		
		2863		

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Aer

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/820,747	RYU ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael P. Nghiem	2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 January 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 8-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1,3-5,8-18 is/are allowed.  
 6) Claim(s) 2 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 09 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

The Amendment filed on January 30, 2006 has been acknowledged.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321□ may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 2 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of copending Application No. 10/820,748 (Ryu et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 of Ryu et al anticipates the claimed invention:

"An inspecting apparatus (testing apparatus, claim 21, line 1) for a semiconductor device (claim 21, line 1) comprising:

- a match plate (claim 21, line 3);
- a contact module (claim 21, line 4) combined with the match plate (claim 21,

lines 3-5), the contact module comprising:

- a radiator (comprises heat sink, claim 21, lines 13-14) to contact the semiconductor device (claim 21, lines 13-15), and
- a tester (lead pusher, claim 21, line 19) to contact leads (claim 21, line 19) of the semiconductor device (claim 21, lines 19-20), and

- a thermally conductive pad (heat flat pushers, line 9) installed on a contacting face of the radiator (claim 21, lines 9, 13, 14), to transfer heat from the semiconductor device to the radiator (claim 21, lines 7-15);

- a plurality of contact modules (claim 21, line 4),
- wherein the match plate is formed with a plurality of combining holes combinable with the plurality of contact modules (claim 21, lines 3-5)."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

Claim 2 would be allowable if rewritten or amended to overcome the double patenting rejection set forth in this Office action.

Claims 1, 3-5, and 8-18 are allowed.

***Reasons For Allowance***

The combination as claimed wherein the inspecting apparatus for the semiconductor device comprising a plurality of contact modules, wherein the match plate is formed with a plurality of combining holes combinable with the plurality of contact modules (claims 2, 18) or the thermally conductive pad is installed on the radiator using a thermally conductive double-sided adhesive member (claim 1) or a first elastic member installed on the circumference of the heat flat pusher to elastically connect the contact block and the lead pusher (claim 11) or the compressible thermally conductive pad conforms to irregularities of the semiconductor device, preventing air from being present between the thermally conductive pad and the semiconductor device when the thermally conductive pad and the semiconductor device are in contact (claim 17) is not disclosed, suggested, or made obvious by the prior art of record.

***Response to Arguments***

Applicant's arguments have been considered but are not moot in view of the new grounds of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-H.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAEL NGHIEM  
PRIMARY EXAMINER

Michael Nghiem

February 19, 2006